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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,381	09/15/2003	Andy Kazmierczak	DJORTH.220A	1613
20995	7590	11/29/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ALI, SHUMAYA B	
			ART UNIT	PAPER NUMBER
			3771	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental
Office Action Summary

	Application No.	Applicant(s)
	10/663,381	KAZMIERCZAK ET AL.
Examiner	Art Unit	
Shumaya B. Ali	3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 November 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 7 and 10-13 is/are allowed.
- 6) Claim(s) 1-6,8,9 and 15-25 is/are rejected.
- 7) Claim(s) 26-28 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: JP 2003-068426

SUPPLEMENTAL ACTION

Response to Arguments

Applicant's argument with respect to earliest priority date of in the reference of Itoi US 6,932,781 B2 used to reject claims 1-6,8,9, and 15-25 being invalid, respectfully considered, and found persuasive. However, Itoi JP 2003-068426 publication date, March 13, 2003 overcomes Applicant's earliest claimed priority date, June 4, 2003. Therefore, rejection filed on 6/5/2006 would be maintained since both US and JP references to Itoi disclose indistinguishable invention. Claims 1-6,8,9 and 15-25 therefore are considered rejected under Itoi JP 2003-068426.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-4, 8, and 15-18 are rejected under 35 U.S.C. 102(a) as being anticipated by Itoi JP 2003-068426. Please refer to US 6,932,781 B2 for English translation.

As to claims 1,15, Itoi in figures 2 and 3 discloses a shoulder sling for supporting a wearer's arm at desired angles of abduction and external rotation, the sling comprising: a support pillow (10, see col.4 lines 27-30) including a contoured medial

surface (3, col.4 liens 31-32) for abutting the wearer's torso, and a lateral surface (5) for operatively contacting and supporting the wearer's arm; a pouch (fig.3, 14) for receiving and at least partially enclosing the wearer's forearm; and a plurality of straps (2 and 9) for securing the support pillow and the pouch to the wearer, wherein a distance between anterior edges of the medial and lateral surfaces is substantially greater than a distance between posterior edges of the medial and lateral surfaces (as seen in figure 2) such that the wearer's arm is maintained in a position of external rotation (see col.4 lines 33-35).

As to claim 2, Itoi discloses wherein the support pillow retains the wearer's arm in a position of approximately 15⁰ of abduction and approximately 15⁰ of external rotation (see fig.7, col.3 lines 25-27; col.4 lines 14-20).

As to claim 3, Itoi discloses wherein the support pillow retains the wearer's arm in a position of approximately 15⁰ of abduction and approximately 30⁰ of external rotation (see fig.7, col.3 lines 25-27; col.4 lines 14-20).

As to claims 4, 17 Itoi discloses wherein a first one of the straps comprises a torso strap (2) that extends from the support pillow adjacent the anterior edge of the medial surface to the support pillow adjacent the posterior edge of the medial surface (as best seen in figure 2).

As to claims 8,16 Itoi discloses wherein the pouch is releasably secured to the support pillow later surface (as seen in figure 3, Velcro 7 allows releasable securement of pouch to the pillow)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,6, 18-20, 23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoi in view of Gaylord US Patent 6,659,971 B2 and in further view of Schaefer US Patent 4,598,701

As to claims 5,18, 19 Itoi discloses limitation as cited for claims 1-4 except for a second one of the strap comprises a chest strap that extends from an anterior surface of the support pillow to an anterior edge of a shoulder pad; However, at the time of the invention such strapping attachment in combination with support pillow and pouch is well known in the art. **Gaylord** discloses shoulder sling with a second one of the straps comprises a chest strap (see fig.1 reference object 65) that extends from an anterior edge of a shoulder pad (see fig.1 reference object 80); **however does not disclose** the strap extends from the anterior edge of a shoulder pad to an anterior surface of the support pillow. **Schaefer teaches** a shoulder abduction splint wherein a chest strap (securing strap) (see fig.1 reference object 24) extends from an attachment joint at the shoulder to

an anterior surface of a support pillow (see fig.1 reference object A). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the chest strap of Itoi in view of Gaylord and in further view of Schaefer in order to secure the strap that extends from an anterior surface of the support pillow to an anterior edge of a shoulder pad for the purposes of properly supporting the wearer's arm.

As to claims 6,18,20 Itoi fails to disclose a third one of the straps comprise a back strap that extends from a posterior edge of the pouch to a posterior edge of the shoulder pad. However, at the time of the invention such strapping attachment in combination with support pillow and pouch is well known in the art. Gaylord discloses the shoulder sling limitation as applied to claim 5, wherein a third one of the straps comprise a back strap (see fig.3, reference object 55) that extends from a posterior edge of the pouch to a posterior edge of the shoulder pad (see col.7 lines 63-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the chest strap of Itoi in view of Gaylord in order to properly support the wearer's arm.

As to claim 23, Itoi in view of Gaylord teaches limitation as cited for claims 1, and 4-6.

As to claim 25, Itoi discloses Velcro hook (figure 1, 8) to secure the torso strap. It is well known in the art that buckles and hook and loop are alternative means for

securing. Therefore, it would have been obvious to one of ordinary skills in the art to use buckle or other means for securing as a matter of design choice.

Claims 9,21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoi JP 2003-068426, in view of Bastyr et al. US Patent 5,407,420

As to claims 9,21, 24 Itoi discloses limitations as cited for claim 1 except for a resilient compressible member secured to an anterior surface of the support pillow. Bastyr et al. teaches an adjustable brace that provides stabilization and immobilization of the shoulder following injury comprising a spherical foam hand bolster attached to the distal end (anterior surface) of a forearm cuff to provide support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand (see fig.1 reference object 40, col.4 lines 64-68). Since Bastyr et. al. forearm is capable of abducting, extending, and rotating a wearer's arm (see col.5 lines 9-12,21-25), Bastyr et al. forearm cuff is considered to act as and meet the same purposes of the pillow disclosed by the applicant. Additionally, a close review of the applicant's disclosure reveals that the purpose and the location of the resilient member are more critical than the specific attachment point. It is important that the member is located where the wearer can easily reach it with the hand on his or her treatment arm (see page 8). Therefore, both the applicant's and Bastyr et al. resilient compressible member are located where the wearer can easily reach it with the hand on his or her treatment arm. **Therefore, it would have been obvious to one of ordinary skill in the art at the**

time of the invention to add a resilient compressible member to the pillow of Itoi in view of Bastyr et al. for the purposes of providing support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand.

Claim Objections

Claim 7 is objected to because of the following informalities: on page 3, second to the last line of claim 7; consider “a” shoulder pad instead of “the” shoulder pad. Appropriate correction is required.

Allowable Subject Matter

Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 7, and 10-13 are allowable over the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS SUPPLEMENTAL ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-W-F 8:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


TEENA MITCHELL
PRIMARY EXAMINER


Shumaya B. Ali
Examiner
Art Unit 3771
